

REMARKS

In summary, claims 1-20 are pending. Claims 1-20 are rejected under 35 U.S.C. § 102. Applicant respectfully traverses the rejection of claims 1-20. Claims 6 and 7 are herein amended. No new matter is added.

Claim Amendments

Claims 6 and 7 are amended to correct a typographical error. Each of claims 6 and 7 originally recited the phrase: "source code module." Claims 6 and 7 are amended to each recite: "source mode module." Support for this amendment is found throughout Applicant's application, such as Fig. 2 and paragraphs 0032 and 0033, for example.

Claim Rejections - 35 U.S.C. §102

Claims 1-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,895,477, issued to Orr *et al.* (hereinafter referred to as "Orr *et al.*").

Claims 1-7

In support of the rejection of independent claim 1, it is asserted in the Office Action at page 3, only that Orr *et al.* teaches "that the new file may be modified to the format of the original file," and "the 'universal object adaptor' functioning as the 'source code preservation module' for making the comparison between the original text file and the modified block of text."

Claim 1 recites various features that appear to have been overlooked. Without an explanation as to how Orr *et al.* teaches every feature of claim 1, Applicant is deprived of an opportunity to provide a meaningful response.

"The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and other wise reply completely at the earliest opportunity." MPEP §706. "In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her

command. When a reference ... shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of reference, if not apparent, must be clearly explained and each rejected claim specified.” 37 CFR §1.104 (c)(2), MPEP §706. To anticipate a claim, a reference must teach every claimed element. MPEP § 2131 (emphasis added). Furthermore, the examiner bears the burden of proof to show patent invalidity. *See In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985). Such proof must amount to a preponderance of the evidence to warrant rejection of claims. *Id.* Examiner has not met his burden.

An explanation as to how Orr *et al.* teaches every feature of claim 1 has not been provided. An example list of overlooked claim features is provided herein. The following list is exemplary and not intended to be representative of all features of claims 1.

- “original text file” (emphasis added)
- “first modified text file”
- “second modified text file”
- “final file with original formatting”

Because no explanation has been provided as to how at least the above features read on Orr *et al.*, Applicant submits that it has not been demonstrated by a preponderance of the evidence that Orr *et al.* teaches each and every element of claim 1, as required in accordance with MPEP § 2131. Further, it is apparent that Orr *et al.* shows or describes an invention other than that claimed by the Applicant, and because Examiner has not designated the particular parts of Orr *et al.* relied upon as nearly as practicable, as required under 37 § CFR 1.104 (b), Applicant is not provided an opportunity to provide a meaningful response to the rejection of claim 1 under 35 U.S.C. § 102.

Accordingly, Applicant requests that Examiner set forth the portions of Orr *et al.* that teach all features of claim 1 in a Non-Final Office Action so that Applicant is provided an opportunity to respond to such new grounds for rejection, or alternatively reconsider and withdraw the rejection of claim 1 and its dependent claims 2-7 under 35 U.S.C. § 102.

Claims 8-16

Similarly, various features of independent claim 8 appear to have been overlooked. In support of the rejection of independent claim 8, it is asserted in the Office Action at page 5, only that Orr *et al.* “generally” teaches “techniques for manipulation of dropping files into document,” and “specifically” teaches “adding new content to fit original content format.”

An explanation as to how Orr *et al.* teaches every feature of claim 8 has not been provided. An example list of overlooked claim features is provided herein. The following list is exemplary and not intended to be representative of all features of claims 8.

- “preserving formatting of an original file”
- “receiving an unmodified file”
- “receiving an unmodified file”
- “comparing the unmodified file and the modified file”
- “applying the at least one modification to the unmodified file”
- “generate a final file having the first format”

Because no explanation has been provided as to how at least the above features read on Orr *et al.*, Applicant submits that it has not been demonstrated by a preponderance of the evidence that Orr *et al.* teaches each and every element of claim 8, as required in accordance with MPEP § 2131. Further, it is apparent that Orr *et al.* shows or describes an invention other than that claimed by the Applicant, and because Examiner has not designated the particular parts of Orr *et al.* relied upon as nearly as practicable, as required under 37 § CFR 1.104 (b), Applicant is not provided an opportunity to provide a meaningful response to the rejection of claim 8 under 35 U.S.C. § 102.

Accordingly, Applicant requests that Examiner set forth the portions of Orr *et al.* that teach all features of claim 8 in a Non-Final Office Action so that Applicant is provided an opportunity to respond to such new grounds for rejection, or alternatively reconsider and withdraw the rejection of claim 8 and its dependent claims 9-16 under 35 U.S.C. § 102.

Claims 17-20

Further, various features of independent claim 17 appear to have been overlooked. In support of the rejection of independent claim 17, it is asserted in the Office Action at page 9, only that Orr *et al.* “use of HTML files for creation of a document as claimed in claim 17.”

An explanation as to how Orr *et al.* teaches every feature of claim 17 has not been provided. An example list of overlooked claim features is provided herein. The following list is exemplary and not intended to be representative of all features of claims 17.

- “a first HTML file”
- “a second HTML file”
- “an unmodified HTML file”
- “a modified HTML file”
- “a final HTML file having the first format”

Because no explanation has been provided as to how at least the above features read on Orr *et al.*, Applicant submits that it has not been demonstrated by a preponderance of the evidence that Orr *et al.* teaches each and every element of claim 17, as required in accordance with MPEP § 2131. Further, it is apparent that Orr *et al.* shows or describes an invention other than that claimed by the Applicant, and because Examiner has not designated the particular parts of Orr *et al.* relied upon as nearly as practicable, as required under 37 § CFR 1.104 (b), Applicant is not provided an opportunity to provide a meaningful response to the rejection of claim 8 under 35 U.S.C. § 102.

Accordingly, Applicant requests that Examiner set forth the portions of Orr *et al.* that teach all features of claim 17 in a Non-Final Office Action so that Applicant is provided an opportunity to respond to such new grounds for rejection, or alternatively reconsider and withdraw the rejection of claim 17 and its dependent claims 18-20 under 35 U.S.C. § 102.

Prior Art Made Of Record

The Examiner considers the following prior art made of record and not relied upon pertinent to Applicant's disclosure: U.S. Patent Number 5,956,737, issued to King *et al.* (hereinafter referred to as "King *et al.*"), characterized as "teaching layout of electronic documents using tree structure," U.S. Patent Number 5,903,902, issued to Orr *et al.*, (hereinafter referred to as "Orr 2"), characterized as "teaching tree structure for an electronic document, separated into content, design, and media aspects," U.S. Patent Number 5,895,476, issued to Orr *et al.* (hereinafter referred to as "Orr 3"), characterized as "teaching editing of electronic documents using a tree structure," U.S. Patent Number 5,694,609, issued to Murata (hereinafter referred to as "Murata"), characterized as "teaching electronic document processing using embedded node structures," U.S. Patent Number 5,555,326, issued to Yamashita *et al.* (hereinafter referred to as "Yamashita *et al.*"), characterized as "teaching extracting a tree structure from a page and creating a layout structure," U.S. Patent Number 5,428,721, issued to Sato *et al.* (hereinafter referred to as "Sato *et al.*"), characterized as "teaching image conversion techniques," and U.S. Patent Application Number 2003/0079177, in the name of Brintzenhofe *et al.* (hereinafter referred to as "Brintzenhofe *et al.*"), characterized as "teaching creation of an electronic document with a tree structure." It is respectfully submitted that King *et al.*, Orr 2, Orr 3, Murata, Yamashita *et al.*, Sato *et al.*, and Brintzenhofe *et al.*, whether considered separately or together, in any combination, neither disclose nor suggest Applicant's claimed invention.

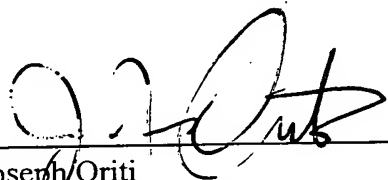
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Conclusion

In view of the foregoing arguments, remarks, and amendments, it is submitted that this application is in condition for allowance. Reconsideration of this application and an early Notice of Allowance are requested. In the event that the Examiner cannot allow this application for any reason, the Examiner is encouraged to contact the undersigned attorney to discuss resolution of any remaining issues.

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